

REMARKS

Applicants submit this Amendment in reply to the Final Office Action mailed October 10, 2008. Before this Amendment, claims 1-45 were pending in this application, of which claims 1, 16, and 31 were independent.

In the final Office Action, the Examiner took the following actions:

- i. rejected claims 1-8, 12-23, 27-38, and 42-45 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,901,214 ("Schaffer"); and
- ii. objected to claims 9-11, 24-26, and 29-41 as being dependent upon a rejected base claim, but indicated the claims would be allowable if rewritten in independent form all limitations of the base claim and any intervening claims.

Applicants have amended independent claims 1, 16, and 31 to include subject matter formerly recited in similar form by dependent claims 5, 20, and 35, respectively. These amendments find support in least paragraphs 0004-07, 0021-24, and 0046-47 of the Specification; Figures 2, 4, and 5; and originally filed claims 5, 20, and 35. In addition, Applicants have cancelled dependent claims 5, 20, and 35 without prejudice or disclaimer and changed the dependency of 6, 21, and 36 to reflect these cancellations. Accordingly, claims 1-4, 6-19, 21-34, and 36-45 are currently pending in this Application.

Applicants respectfully traverse all pending rejections, as follows.

I. Rejections Under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 1-8, 12-23, 27-38, and 42-45 under 35 U.S.C. § 103(a) as being unpatentable over *Schaffer*. A *prima facie* case of obviousness has not been established.

“The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements.” M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. § 2143.01(III) (emphasis in original). “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. M.P.E.P. § 2141.02(I) (emphases in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Here, a *prima facie* case of obviousness has not been established because the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Examiner has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

As presently amended, claim 1 now recites “creating the alternative delivery point code . . . , wherein the creating comprises [(1)] calculating, based on the secondary element, a random number or a pseudo-random number and [(2)] setting at least one digit of the alternative delivery point code to the calculated number.” *Schaffer* does not teach or suggest these features, nor would its teachings render them obvious to one of ordinary skill in the art.

Schaffer discloses a “one number intelligent call processing system” that, as part of automating consumer telephone calls, attempts to precisely identify a caller’s location. Title; 1:55-2:22. In more detail, *Schaffer* discloses creating a “spatial key,” which is “a standardized precise and universal database linkage key that can be assigned to all the United States telephone numbers and [several national] databases.” 4:31-53. As *Schaffer* explains, this spatial key may be generated using several “candidates,” including two of which the Examiner points to as relevant teachings to the Applicant’s claims: a telephone number and a USPS Zip Code. As explained below, however, none of *Schaffer*’s teachings regarding either of these candidates, discloses or renders obvious the above-noted recitations of the Applicants’ independent claims.

First, the portions of *Schaffer* the Examiner relies on do not even discuss performing a calculation to create a Delivery Point Code. Rather, those portions merely

discuss appending digits to a standard Delivery Point Code to create an Extended Zip 19-digit Code capable of identifying a caller's unique housing or business unit within a multiple unit building or firm. See 11:26-56. In more detail, *Schaffer* creates this "extended Zip 19-digit code" beginning with a standard Delivery Point Code(i.e., a ZIP+6 code having 11 digits). See 11:40-45. It then retrieves a "secondary address" from the USPS Address Management system (i.e., an additional code having 8 digits), and appends the secondary address to the end of the standard Delivery Point Code, thereby creating the extended 19-digit ZIP Code. See *id.* Applicants respectfully submit that contrary to the Examiner's assertion, this appending a secondary address to a standard Delivery Point Code does not fairly equate to performing any "calculating."

Second, even assuming for the sake of argument the Examiner's position¹ that the above-described process of *Schaffer* could teach or suggest "calculating" at all, *Schaffer* still plainly does disclose "calculat[ing], based on the secondary element, a random or pseudo-random number" and "setting at least one digit of the alternative delivery point code to the calculated number," as recited by independent claim 1. Rather, the portions of *Schaffer* the Examiner relies upon as allegedly disclosing "calculating a random number,"² do not even relate to creating a Delivery Point Code. Instead, the cited disclosure discusses a telephone number as a "spatial key," as an alternative to using a USPS ZIP code. See e.g., 7:35-55.

¹ In the Office Action, the Examiner conceded that *Schaffer* "does not specifically disclose 'calculating,'" (OA at p. 3), but asserts that *Schaffer* nevertheless discloses performing a calculation "subdivid[ing] the delivery point code inherently suggests calculating "since the secondary address is appended to the subdivided [Delivery Point Code]."

² The Examiner addressed this feature in the Office Action at pages 5-6 with regard to formerly pending dependent claim 5, which recited this feature in similar form.

Apparently, the Examiner cites this portion of *Shaffer's* disclosure because it mentions "[u]sually over time, the line numbers associated with a [telephone number prefix] become randomly distributed across the locations of the households and businesses" 7:40-43. This reference to "random," however, merely identifies a "deficiency" of using a telephone number to generate the spatial key of *Schaffer's* invention. See 7:45-55. *Schaffer* nowhere teaches or suggests, explicitly or inherently, any need or desire to "creat[e] [a] delivery point code [by] calculating . . . one of a random number or a pseudo-random number," as recited in claim 1. Furthermore, at least because this disclosure relates to telephone numbers, rather than Delivery Point Codes, it also does not teach or suggest "setting at least one digit of the alternative delivery point code to the calculated number," as also recited in claim 1.

In view of at least these mischaracterizations of *Schaffer*, the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the invention as recited by independent claim 1. Furthermore, amended independent claims 16 and 31 recite similar language to that discussed above with respect to claim 1, and are therefore allowable over *Schaffer* for at least the same reasons. Thus, the Examiner has failed to clearly articulate a reason why these claims would have been obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established with respect to independent claims 1, 16, and 31, and the rejection under 35 U.S.C. § 103(a) must be withdrawn. For the same reasons, claims 2-4, 6-19, 21-30, 31-34, and 36-45 are also allowable at least due to their dependence from independent claims 1, 16, and 31.

II. Objections to Claims 9-11, 24-26, and 29-41 as Being Dependent on a Rejected Base Claim

For the reasons described above, the Office has not established a *prima facie* case of obviousness for independent claims 1, 16, and 31. Accordingly, none of claims dependent claims 9-11, 24-26, and 29-41 depends on a properly rejected base claim.

Conclusion³

In view of the foregoing remarks, Applicant submits that the pending claims, as amended, are neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests that the Examiner reconsider and withdraw the rejections and objections to the pending claims and pass this application to issue.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: April 6, 2009

/s/ Benjamin D. Bailey
By: _____
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³ It is to be understood that Applicants are in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification or abstract and or shown in the drawings. Rather, Applicants believe that they are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.